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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KAORI SASADA, NORIKO TOMITA,  
TOMOKO IKEDA, and TOMO OSAWA<sup>1</sup>

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Appeal 2017-006322  
Application 13/511,378  
Technology Center 1600

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Before DEMETRA J. MILLS, FRANCISCO C. PRATS, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134(a) involves claims to lip cosmetics.  
The Examiner rejected the claims for obviousness.

We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The sole rejection before us for review is the Examiner's rejection of  
claims 29, 43, 46–50, 56, and 59–64 under 35 U.S.C. §103(a) for  
obviousness over Arnaud,<sup>2</sup> Lu,<sup>3</sup> Yuki,<sup>4</sup> Hoffmann,<sup>5</sup> and Patil.<sup>6</sup> App. Br. 9.

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<sup>1</sup> Appellants identify SHISEIDO COMPANY, LTD., as the real party in  
interest. App. Br. 3.

<sup>2</sup> US 2001/0031269 (published Oct. 18, 2001).

<sup>3</sup> EP 1 661 549 A1 (published May 31, 2006).

Claims 29 and 50, the independent claims on appeal, illustrate the claimed subject matter and read as follows (App. Br. 22, 23 (emphasis added)):

29. A lip cosmetic comprising:
- (a) 10 to 30 mass% of hydrogenated polyisobutene;
  - (b) 30 to 70 mass% of one or more kinds of methyl phenyl silicones that separate when mixed with (a) at 25 °C wherein the methyl phenyl silicone(s) comprises trimethyl pentaphenyl trisiloxane and optionally one or more selected from the group consisting of diphenylsiloxo phenyl trimethicone and diphenyl dimethicone;
  - (c) 0.5 to 8 mass% of one or two kinds of lipophilic surfactants that does not separate both when mixed with component (a) and when mixed with component (b) at 90° C wherein the lipophilic surfactant(s) is selected from the group consisting of sorbitan sesquiisostearate and propylene glycol monostearate;
  - (d) 5 to 12 mass% of a wax; and
- 5 mass % or less of a silicone-treated pearlescent agent as a coloring material.

50. A lip cosmetic comprising the following components *and none of volatile oil components*:

- (a) 10 to 30 mass% of hydrogenated polyisobutene;
- (b) 30 to 70 mass% of at least two kinds of methyl phenyl silicones that separate when mixed with (a) at 25 °C wherein the methyl phenyl silicones comprise trimethyl pentaphenyl trisiloxane and diphenylsiloxo phenyl trimethicone, and optionally diphenyl dimethicone, wherein said two kinds of methyl phenyl silicones include the diphenylsiloxo phenyl trimethicone at 1 to 17 mass % relative to the total amount of the cosmetic;

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<sup>4</sup> JP 2010-090079 (published April 22, 2010) (as translated).

<sup>5</sup> EP 2 025 321 A1 (published Feb. 18, 2009).

<sup>6</sup> US 2004/0156806 A1 (published Aug. 12, 2004).

(c) 0.5 to 8 mass% of one or two kinds of lipophilic surfactants that does not separate both when mixed with component (a) and when mixed with component (b) at 90 °C wherein the lipophilic surfactant(s) is selected from the group consisting of sorbitan sesquiisostearate and propylene glycol monostearate;

(d) 5 to 12 mass% of a wax; and  
5 mass % or less of a silicone-treated pearlescent agent as a coloring material.

## OBVIOUSNESS

### *The Examiner's Prima Facie Case*

The Final Action from which this appeal is taken does not expressly state, or direct us to, the obviousness rationale underlying the appealed rejection. *See* Final Action 2 (entered January 28, 2016). Nonetheless, we note that the Examiner's reasoning appears in the previous Non-Final Action. *See* Non-Final Act 2–6 (entered September 10, 2015).

The Examiner cited Arnaud as disclosing a lip cosmetic that contained several of the ingredients required by Appellants' claims, and stated in particular that "Arnaud teaches phenyl trimethicones in general but does not expressly disclose diphenylsiloxo phenyl trimethicone or trimethyl pentaphenyl trisiloxane (current claims 29(b) 46, and 50, 51, 54-56[])." Non-Final Act. 4.

The Examiner cited Lu, Yuki, and Hoffman as evidence that diphenylsiloxo phenyl trimethicone and trimethyl pentaphenyl trisiloxane were known in the art to be phenyl trimethicones useful in cosmetic compositions, including lip cosmetics. Non-Final Act. 4–5. The Examiner cited Patil as evidence that sorbitan sesquiisostearate was a suitable surfactant in lipsticks that also contain phenyl trimethicones. *Id.* at 5.

Based on the references' teachings, the Examiner concluded as follows:

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Arnaud, Lu et al., Yu et al. and Patil et al. and reach the instant claims. One of ordinary skill in the art would find suggestion and/or motivation to combine at least the Arnaud, Lu et al., Yu et al. and Patil et al. references because they teach cosmetic compositions comprising similar non-volatile silicone compounds useful for preparing cosmetic stick products such as lip stick. *See In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) ("It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose .... [T]he idea of combining them flows logically from their having been individually taught in the prior art.")

Non-Final Act. 5.

The Examiner further reasoned as follows:

[A] skilled artisan would have reasonable expectation of success in the combination of references, in particular incorporating diphenylsiloxo phenyl trimethicone, in view of Hoffman's teaching of diphenylsiloxo phenyl trimethicone as an obvious variant of the non-volatile silicone compounds taught by Arnaud.

Further, regarding trimethyl pentaphenyl trisiloxane, is it used widely in the art of lipstick or lipgloss formulation and is a well-known skin conditioning agent and emollient. It is also considered a non-volatile oil that remains on the lips to give a durable gloss. Where the objective technical problem appears to be the provision of an alternative composition for lips having a glossy finish, the skilled person would consider adding trimethyl pentaphenyl trisiloxane without any inventive thinking.

Non-Final Act 6.

Appellants contend that they combine the particular set of ingredients recited in claims 29 and 50 in order to provide a lip cosmetic with improved secondary adhesion resistance and stability. App. Br. 10–13. As to the Examiner’s *prima facie* case, Appellants contend that the cited references fail to suggest the particular combination of ingredients recited in the claims, and note in particular that the compositions of each of the cited references differs significantly from the claimed compositions, in that each of the cited references lacks several of the ingredients required by the rejected claims. *Id.* at 13–16. Appellants note, moreover, that claim 50 excludes volatile oils from the claimed compositions, whereas Arnaud requires the presence of a volatile oil in its compositions. *Id.* at 19; *see also* Reply Br. 8.

In response to these arguments, the Examiner contends that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” Ans. 2 (citing *In re Keller*, 642 F.2d 413 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986)).

#### *Analysis*

As stated in *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992):

[T]he examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability. . . .

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

In *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), although the Supreme Court emphasized “an expansive and flexible approach” to the obviousness question, it also reaffirmed the importance of determining

“whether there was an apparent reason to combine the known elements *in the fashion claimed* by the patent at issue.” *Id.* at 418 (emphasis added).

Thus, “[o]bviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Laboratories, Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011).

Instead, “[i]n determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

Appellants persuade us that the Examiner has not explained sufficiently why the cited references would have suggested preparing the specific compositions recited in claims 29 and 50. In particular, as noted above, the Examiner urges that an ordinary artisan would have combined the cited references’ teachings to arrive at the claimed combination of elements.

It is well settled, however, that as a predicate to a conclusion of obviousness, the “differences between the prior art and the claims at issue are to be ascertained.” *KSR*, 550 U.S. at 406 (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)). Our reviewing court has explained, in particular, that “section 103 requires a fact-intensive comparison of the claimed process with the prior art rather than the mechanical application of one or another *per se* rule.” *In re Ochiai*, 71 F.3d 1565, 1571 (Fed. Cir. 1995).

In the present case, the Examiner does not explain with adequate specificity which particular reference must be modified to yield the

compositions of claims 29 and 50, what particular modifications must be made to the teachings of that reference, and why an ordinary artisan would have made those particular modifications. Although the Examiner appears to rely on Arnaud as describing compositions meeting the majority of the claimed features, the Examiner does not explain with adequate particularity *each of the differences* between Arnaud and the rejected claims, how, *specifically*, Arnaud must be modified to arrive at the claimed composition, *and why* an ordinary artisan would have made that modification.

We are not persuaded that citation of *In re Kerkhoven* as a *per se* rule of obviousness is an adequate substitution for that type of analysis. *See In re Ochiai*, 71 F.3d at 1571 (“[S]ection 103 requires a fact-intensive comparison of the claimed process with the prior art rather than the mechanical application of one or another *per se* rule.”). Moreover, although we agree in general that argument directed to individual references is insufficient when obviousness is based on a combination of references, in this instance, as noted, the Examiner does not explain with adequate specificity *how* the references are being combined.

As to the identified rationale for modifying the prior art, we note the Examiner’s contention that “[w]here the objective technical problem appears to be the provision of an alternative composition for lips having a glossy finish, the skilled person would consider adding trimethyl pentaphenyl trisiloxane without any inventive thinking.” Non-Final Act. 6.

The Examiner, however, does not support that contention by reference to any specific teaching in the cited references. *See KSR*, 550 U.S. at 418 (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning



with some rational underpinning to support the legal conclusion of obviousness.”). Moreover, as explained in MPEP § 2141.02,II., “[d]istilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).

Because the Examiner’s rejection lacks specific findings as to each of the differences between the prior art and the claims, and a specific articulation of how and why the prior art must be modified to yield the composition, we are not persuaded that the Examiner has adequately analyzed the claimed subject matter as a whole. To that end, for example, we note, as Appellants argue, that Arnaud requires a volatile oil in its compositions (*see* Arnaud, abstract), whereas Appellants’ claim 50 excludes volatile oils (*see* App. Br. 23).

We note also the Examiner’s contention that an ordinary artisan would have had a “reasonable expectation of success in the combination of references, in particular incorporating diphenylsiloxyl phenyl trimethicone, in view of Hoffman’s teaching of diphenylsiloxyl phenyl trimethicone as an obvious variant of the non-volatile silicone compounds taught by Arnaud.” Non-Final Act. 6. Hoffmann, however, is directed to hair conditioning compositions (*see* Hoffmann, abstract), and the Examiner has not explained with adequate specificity why a silicone compound used in hair conditioners would be an obvious variant of such a compound when used in Arnaud’s lip cosmetics.

In sum, for the reasons discussed, we are not persuaded that the Examiner has advanced a persuasive, specific, fact-based explanation as to why Arnaud, Lu, Yuki, Hoffmann, and Patil would have suggested the lip

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cosmetics recited in Appellants' claims 29 and 50 to an ordinary artisan.  
Accordingly, we reverse the Examiner's rejection of those claims, and their dependent claims, over those references.

REVERSED